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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,583

06/15/2005

Mischa Stieger

112701-625

9052

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05/11/2009

EXAMINER

HOGAN, JAMES SEAN

ART UNIT

PAPER NUMBER

3752

NOTIFICATION DATE

DELIVERY MODE

05/11/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,583	<b>Applicant(s)</b> STIEGER ET AL.	
	<b>Examiner</b> JAMES S. HOGAN	<b>Art Unit</b> 3752	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed March 17, 2009 have been fully considered but they are not persuasive. The Examiner maintains that due to sanitation rules such as NSF Standards 2, 8, and 18, it would be in the Applicant's best interest to include approved materials for the construction of devices falling within the criterion set forth by said standards. Included within those standards may or may not include standards by which an item may be disposable as well. Therefore, the instance that the nozzle be disposable and the use of plastics that are compatible to food use are known strategies for qualifying an apparatus for sanitation qualifications and therefore are not qualifying for a patented claim. However, in light of Applicant's arguments, as filed, a secondary reference has been obtained

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,499,389 to Probst in view of U.S. Patent No. 5,768,981 to Cicchetti

3. As per claims 1, 11 and 12, Probst discloses a nozzle that can be fitted onto the steam outlet (4) of a coffee machine intended to froth a liquid, the nozzle having a mouth (at (3)) for receiving letting in steam, a restriction (3a) in a continuation of the

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said mouth, and a flared zone(13) along the axis of the said restriction and of the said mouth to allow the liquid out, having a cross section more or less approximately equal to the cross section of the mouth, and a pipe (6) perpendicular to the mouth for allowing in liquid, and an air inlet (8), the air inlet extending from the pipe at an angle of 0°. Probst does not necessarily show the nozzle being made of one piece, nor the material it is made of, however, Cicchetti teaches a mostly-one piece (25) housing of a mouth (15), outlet (20) and perpendicular milk inlet (17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Probst with a unitary housing as suggested by Cicchetti. Doing so would provide a unitary construction capable of being disposable and because (a) the Probst reference and the Cicchetti reference are *known work in one of field of endeavor*, (b) such modification is merely the use of known technique to improve a similar device by Applicant and (c) such modification, i.e. choosing from a finite number of predictable solutions, is not of innovation but of ordinary skill and common sense. *KSR, International Co. v. Teleflex Inc.*, 550 U.S. (2007). Similarly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have proclaimed a compatible material for the nozzle, (i.e. food grade plastic, e.g. propylene), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See *in re Leshin*, 125 USPQ 416. Further, as Probst and Cicchetti do not teach a disposable nozzle piece, doing so is know to be making a piece “portable”, and it has been held that making an old device portable or movable without producing any new and expected

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results involves only routine skill in the art. See *In re Lindberg*, 93 USPQ 23 (CCPA 1952).

4. As per claim 2, the air inlet of Probst is shown (See Figure 1) as part of the pipe.

5. As per claim 3, the air inlet of Probst, as best as can be determined, opens at a right angle.

6. As per claim 5, the flared zone of Probst is taught to be an emulsifying chamber which by definition would break a jet.

7. As per claim 6, as best as can be determined, a blind ring (17) and settling segment (16) cooperate to create a stabilizing zone at the outlet of Probst.

8. As per claim 7, neither Probst nor Cicchetti teach a specific material for the nozzle, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to have chosen a desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See *in re Leshin*, 125 USPQ 416.

As per claims 8-10, neither Probst nor Cicchetti teach specific sizes for any one piece of the nozzle assembly, however, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize 1-3 mm for the air inlet, 10 to 15 mm for the mouth and 2 to 4mm for the restriction, and 4-20 mm for a stabilization zone, since our reviewing courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the

prior art device, the claimed device was not patentably distinct from the prior art device. Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES S. HOGAN whose telephone number is (571)272-4902. The examiner can normally be reached on Mon-Fri, 6:00a-3:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571)272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S. H./

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Examiner, Art Unit 3752

/Len Tran/

Supervisory Patent Examiner, Art Unit 3752